

REMARKS/ARGUMENTS

These remarks are submitted in response to the office action dated October 4, 2005 (Office Action). As this response is timely filed before the expiration of the 3-month shortened statutory period, no fee is believed due.

Claims 1, 5-6, 8-10, 12, 14, 17-20, 24, 25, 27-29, 31, 33 and 36-37 were rejected in the Office Action under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Patent Application No. 2002/002313 to Wu, *et al.* (Wu). Claims 3-4, 13, 15, 22, 23, 32, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu in view of U.S. Patent Number 6,697,474 to Hanson, *et al.* (Hanson).

Applicants thank the Examiner for his acknowledgment at paragraph 34 that the terminal disclaimer filed on July 21, 2005, has been accepted and recorded.

Applicants have amended each of independent Claims 1, 9, 18, 20, and 28 to emphasize certain aspects of Applicants' invention. Dependent Claims 8, 12, 19, 26, 27, and 31 have been cancelled. The amended claims are fully supported throughout the Specification, as discussed herein. (See, e.g., Specification, pp. 3-4, line 27 - line 2; p. 10, lines 9-19; and p. 11, lines 6-11.) No new matter has been introduced by virtue of these amendments.

I. Applicants' Invention

It may be useful to reiterate certain aspects of Applicants' invention prior to addressing the cited references. One embodiment of the invention, as typified by amended independent Claim 1, is an instant messaging or chat (IM/chat) communication method. The method can include inserting in an instant message (IM) a voice conference identifier comprising a voice conference call list identifying conference call nodes. The method also can include embedding computer program code in the IM. (See, e.g.,

Specification, pp. 3-4, line 27 - line 2; p. 10, lines 9-19.) Execution of the computer program code at a recipient node establishes a voice communications link between an IM sender and a recipient at the recipient node. (See, e.g., Specification, p. 11, lines 6-11.)

The method further can include transmitting the IM from the sender to the recipient at the recipient node. At the recipient node, a recipient client can detect the voice conference identifier within the IM. Responsive to the detecting step, an IM interface of the recipient can display a user-selectable text or graphic symbol, and responsive to a user-selection of the displayed text or graphic symbol, a voice communication link between the recipient and the sender can be established using the computer program code embedded in the IM.

II. The Claims Define Over The Prior Art

As already noted, independent Claims 1, 9, 18, 20, and 28 were rejected as being anticipated by Wu. Applicants respectfully submit that Wu fails to expressly or inherently teach every aspect of Applicants' invention. None of the references, alone or in combination, teach or suggest every feature of Applicants' invention.

For example, none of the references teach the embedding of computer program code in an IM, as recited in amended independent Claims 1, 9, 18, 20, and 28. Accordingly, Wu and other the references further fail to teach the establishment of a voice communications link between an IM sender and a recipient by executing computer program code embedded in an IM, as recited in each of independent Claims 1, 9, 18, 20, and 28, as amended. The references likewise fail to teach that the program code is executed at a recipient node or that it is executed in response to a recipient's selecting a symbol displayed in response to detecting the IM at the recipient node, as also recited in the amended independent claims.

Wu concerns the transferring of electronic data between a sender and a recipient. Electronic data transfer in Wu includes enabling instant messaging communications between the sender and at least one recipient. (See, e.g., paragraphs 0005 and 0014; see also Abstract.)

Notably, instant messaging in Wu is effected exclusively through "an instant messaging host" or host system. (Paragraphs 0005, 0014, 0019, 0020, 0022-0024, 0029-0031, 0036-0040, 0046-0050, 0060-0075.) More particularly, both the sender and recipient in Wu communicate with one another by connecting to the host system. The host system authenticates text messages between the sender and recipient, determines and reports the capabilities of each, and, most importantly in the present context, establishes a talk session between the sender and recipient. (See, e.g., paragraphs 0060-0075; see also FIG. 6, especially elements 602a, 602b, and 604, and steps 655, 660, 665, and 670.)

In a portion of Wu cited in the Office Action, a talk session begins by a sender sending an instant message designating one or more recipients. (Paragraph 0066.) The host system authenticates the message, determines the capabilities of the sender and one or more recipients, and provides a report of the respective capabilities. (Paragraph 0067 and 0068.) The host system sends instant messages that allow the participants to become "talk enabled" by selecting a displayed user interface "button." (Paragraph 0069.)

Wu, however, nowhere relies on sending an instant message having embedded therein software code for establishing a voice communication link between the sender and recipient. Indeed, doing so would be superfluous, indeed wasteful, given Wu's reliance on a host system for facilitating voice communication between a sender and recipient. In Wu, it is the host to which both the sender and recipient connect that establishes a voice communication link (i.e., "talk session"). (FIG. 6, element 604, and steps 655, 660, 665, and 670.)

As clearly shown in FIG. 6, the sender **602a** in Wu connects to a host **604**. The recipient **602b** in Wu likewise connects to the host **604**. To establish a talk session, the host **604** in Wu authenticates a talk request from the sender **602a** and sends the request to the recipient **602b**. No software for establishing the talk session is embedded in the forwarded request to the recipient **602b** with Wu, however. The software for establishing the talk session must reside at the host **604** because it is explicitly the host that carries out the steps for establishing the talk session. (Paragraphs 0072-0075 and, especially, FIG. 6, steps **655**, **660**, **665**, and **670**.)

Accordingly, Wu is distinct from Applicants' invention in at least two significant respects. Firstly, Wu does not expressly or inherently teach the sending of an IM message that includes embedded software for establishing a voice communications link. Secondly, the software for establishing the voice communications link is not executed at a recipient node; in Wu the software establishing the voice communications link (i.e., the "talk session") executes in a host system to which both a sender and recipient connect.

Applicants respectfully maintain, therefore, that Wu fails to expressly or inherently teach every feature recited in amended independent Claims 1, 9, 18, 20, and 28, and that the claims thus define over the prior art. Applicants respectfully maintain further that, whereas each of the remaining claims depend from one of the amended independent claims while reciting additional features, dependent Claims 2-7, 10, 11-17, 21-25, and 29-37 likewise define over the prior art.

III. Applicants' Invention Predates Hanson

Applicants additionally note that the rejections of dependent Claims 3-4, 13, 16, 22-23, 32 and 35 are each based on a combination of references that includes Hanson. Applicants respectfully assert that they conceived of their invention and actively pursued its reduction to practice from a time prior to the May 16, 2001, effective date of Hanson.

Applicants thus respectfully maintain that Hanson can not be applied against Applicants' invention. In support of their assertion, Applicants herewith submit their Declarations along with evidence of activity on specific dates establishing conception and continuing diligence from a time prior to the effective date of Hanson.

The Declarations are accompanied by a copy of the Applicants' Confidential Invention Disclosure No. BOC8-2000-0054 (Disclosure) entitled "Instant Messaging/Chat Client with 'Set-up a Voice/Phone Conference' Feature." The Disclosure was submitted on June 7, 2000, to an IP professional employed by the assignee of the invention, International Business Machines Corporation (IBM). The Disclosure demonstrates proof of conception for the claimed subject matter of the Applicants' invention at least as early as June 7, 2000, which predates the May 16, 2001 effective date of Hanson.

The Disclosure is an IBM confidential disclosure form, which is a standardized document utilized by IBM and submitted by its inventors upon their conception of an invention. IBM has established internal procedures governing the use of such confidential disclosure forms. The procedures preclude substantive modifications to a disclosure form subsequent to its submission to an IBM Attorney/Patent Professional. Instead, any changes and/or additions are appended as an attachment to an IBM confidential disclosure form together with the date the attachment was added.

The present application, including each claim, was prepared based upon Applicants' Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures, the inventors reviewed the application prior to its submission to the U.S. Patent and Trademark Office to ensure that the claims and material contained therein were fully supported by the Disclosure.

The Disclosure provided the basis of each of the claims in the application. The Disclosure explicitly describes initiating a voice/phone conference by selecting a symbol

or icon in an instant messaging or chat session. Notably, in the present context, the Disclosure explicitly states that the voice communications link can be established over a PSTN. (See Paragraph 1.)

Applicants exercised due diligence from prior to the effective date of Hanson, to the date the present application was filed. With respect to Applicants' diligence it is to be noted that, as set forth in the Declarations, once an IBM disclosure form is completed, the disclosure is reviewed by an internal Invention Review Board (the Board) within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon the Board's reaching a decision to prepare an application, outside counsel is selected to prepare the application, and instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. Outside counsel prepares a draft of the application that is reviewed by each inventor. The inventors, according to this standard procedure, must be satisfied that the application sufficiently details the inventive concepts described in the Disclosure.

During the period between June 7, 2000 and January 3, 2002, an outside search firm conducted an initial patent search, the Board assigned the application to outside counsel, and outside counsel drafted the present application. The draft application prepared by outside counsel was reviewed by the inventors, with whose input the application was finalized in its submitted form. This activity of reviewing a patent application is consistent with those exemplary activities noted as satisfying the legal requirements for a showing of diligence. *See, e.g.,* MPEP 715.07(a). Evidence of these activities are presented in Composite Exhibit "A," attached hereto:

1. Correspondence from IBM to outside counsel on October 2, 2000, instructing outside counsel to prepare and file Application;
2. Correspondence from outside counsel to IBM on October 11, 2000, confirming assignment;

3. Facsimile correspondence from outside counsel to inventor Creamer on May 9, 2001, forwarding a draft of the Application;

4. Facsimile correspondence from outside counsel to inventor Walters on July 6, 2001, forwarding a copy of the Application;

5. E-mail correspondence from the outside counsel's administrative staff to the IBM IP Law Department on September 25, 2001, requesting the follow-up on the draft application forwarded to inventor Walters;

6. E-mail correspondence from the outside counsel's administrative staff to the IBM IP Law Department on September 25, 2001, forwarding a copy of the draft Application and drawings;

7. E-mail correspondence from the IBM IP Law Department to outside counsel's administrative staff on September 27, 2001, requesting inventor Walter's review and approval of the Application;

9. Correspondence from outside counsel to inventor Walters on October 1, 2002, forwarding the draft Application;

10. Notation to outside counsel's file indicating a telephone call was received on October 24, 2001, from the IBM IP Law Department requesting the Application be filed on January 2, 2002.

As a standard practice, outside counsel prepares cases on a "first come, first served" basis, though applications associated with bar dates are granted priority within the work queue. As proof that the present application was included within the work queue and receiving attention therein, Applicants have provided the hand written docket sheets from January 2, 2001, March, 2, 2001, April 2, 2001, May 2, 2001, June 2, 2001, July 3, 2001, as well as the electronic docket sheets titled "Actions Due," attached hereto as Composite Exhibit "B."

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Applicants respectfully submit that the evidence convincingly establishes reasonable diligence from a time prior to the effective date of Hanson to the filing date of the present Application. Accordingly, Applicants respectfully maintain that when coupled with the evidence of conception, the evidence of Applicants' diligence effectively removes Hanson from consideration against Applicants invention and, therefore, each of the claims defines over the prior art.

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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